

REMARKS

Claim Rejections - 35 USC § 102

The only rejection of the claims is of claims 1-4 as being anticipated under 35 U.S.C. 102(b) by "Toshiba", JP-2001-316744.

Claim 1 of the present application recites an alkaline storage battery comprising a negative electrode, a positive electrode comprising nickel hydroxide as a positive electrode active material, and an alkaline electrolyte, wherein the negative electrode comprises (a) a hydrogen absorbing alloy represented by $\text{Ln}_{1-x}\text{Mg}_x\text{Ni}_{y-a}\text{M}_a$ (where Ln is at least one element selected from rare earth elements, M is at least one element selected from the group consisting of Al, V, Nb, Ta, Cr, Mo, Mn, Fe, Co, Ga, Zn, Sn, In, Cu, Si and P, $0.05 \leq x < 0.20$, $2.8 \leq y \leq 3.9$ and $0.10 \leq a \leq 0.50$) and (b) carbon as a conductive agent, and wherein the hydrogen content in the hydrogen absorbing alloy is not greater than 0.01 weight % when the battery is activated and is discharged to 1.0 V at one hour rate (It).

Claim 2 recites an alkaline storage battery that differs from that of claim 1 only in that, instead of the limitation concerning hydrogen content, the hydrogen absorbing alloy is limited with respect to water content, i.e., a water content of not greater than

0.13 weight % when the battery is activated and is discharged to 1.0 V at one hour rate (It).

The position of the Office is that Toshiba discloses an alkaline storage battery which inherently includes each of the limitations recited in claims 1 and 2 of the present application. Table 1 of Toshiba identifies a hydrogen absorbing alloy (the third alloy listed in the table, Example 2) that the Office alleges is within the scope of the formula recited in claims 1 and 2. The Office is taking the position that because the hydrogen absorbing alloy in Table 1 of Toshiba is within the scope of the formula recited in claims 1 and 2, the alloy inherently has a hydrogen content and water content as recited in claims 1 and 2, respectively.

Applicants respectfully submit that Toshiba does not support the anticipation rejection.

First, none of the alloys identified in Table 1 of Toshiba is within the scope of the formula for the hydrogen absorbing alloy recited in claims 1 and 2. More specifically, in the hydrogen absorbing alloy $\text{Ln}_{1-x}\text{Mg}_x\text{Ni}_{y-a}\text{M}_a$ of the present invention, $0.10 \leq a \leq 0.50$. In the alloys of Toshiba, $a = 0.66$ (i.e., $(0.16 + 0.01 + 0.02 + 0.01) \times 3.3$).

Second, an alloy within the scope of the formula recited in claims 1 and 2 will not necessarily have a hydrogen content and water content within the scope of the limitations recited in claims 1 and 2. The conditions of preparation of the alloy are important in controlling the hydrogen content and water content of the alloy. As described in the present application on page 6, lines 14-18:

The hydrogen and water content in the hydrogen absorbing alloy are a function primarily of the composition of the alloy and can be adjusted, as required, by controlling the conditions of preparing the alloy, i.e., dissolution, casting and heat treatment.

This description shows that alloys within the scope of the formula recited in the claims will not necessarily have a hydrogen content or water content within the scope of the claims. Inherency under 35 U.S.C. § 102 must be a certainty - not a possibility.

Toshiba, therefore, is insufficient to support a case of inherency of the alkaline storage battery of the present invention within the meaning of 35 U.S.C. § 102(b) and removal of the rejection is in order.

The foregoing is believed to be a complete and proper response to the Office Action dated August 4, 2005, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone

PATENT APPLN. NO. 10/758,541
RESPONSE UNDER 37 C.F.R. §1.111

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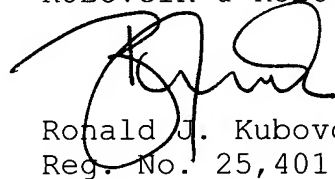
interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

KUBOVCIK & KUBOVCIK



Ronald J. Kubovcik
Reg. No. 25,401

Atty. Case No. SNY-049
The Farragut Building
Suite 710
900 17th Street, N.W.
Washington, D.C. 20006
Tel: (202) 887-9023
Fax: (202) 887-9093
RJK/KTK/ff